

**BEST AVAILABLE COPY****REMARKS**

The Office Action mailed November 3, 2005 has been carefully reviewed and, in view of the above amendments and following remarks, reconsideration and allowance of the application are respectfully requested.

**I. Claim Summary**

Claims 1-33, 43-51, and 57-62 are currently pending in the application, with claims 1, 18, 28, 43, and 57 being independent claims. Claims 34-42 and 52-56 are cancelled and claims 57-62 are added, in accordance with the above amendments.

**II. Office Action Summary**

The following claim rejections were submitted by the Examiner in the outstanding Office Action:

- Claims 1-4, 6-12, 17-19, 21-25, 34-36, 38-40, 43-45, and 47 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Number 6,131,202 to Yan;
- Claims 5, 20, 28-31, 37, and 46 are rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of Yan and U.S. Patent Number 6,052,825 to Dodd;
- Claims 13-16, 26-27, 41-42, and 48-56 are rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of Yan and U.S. Patent Application Publication 2003/0226193 to Wang; and
- Claims 32 and 33 are rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of Yan, Dodd, and Wang.

**III. Discussion of Claims 1-17**

Independent claim 1 recites an article of headwear having an adjustment system for accommodating various head dimensions. The headwear includes a crown for covering at least a portion of a head. The crown is at least partially formed of a first elastic material. In addition, the crown includes a strip of a second elastic material that is screenprinted onto a surface of the crown.

The Office Action rejects independent claim 1 as being anticipated by Yan. As discussed in greater detail below, however, Yan does not teach or suggest an elastic material that is

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screenprinted onto a surface of the crown. Furthermore, Yan teaches away from this configuration.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Yan discloses a headwear configuration having "a head liner or sweatband 24...consisting of a thin foam comfortable material 26 which has overlaying it a fabric covering 28 preferably of the same color and material as that comprising the gores" (Yan, column 3, lines 17-21). As seen in the cross-section of Figure 5, the sweatband (element 24) has a polymer foam element (element 26) and a fabric layer (element 28) that covers or otherwise extends around the exterior of the foam element. Furthermore, Yan states that the "foam liner is...sewn within the fabric making up the cap and is sewn with the same type of thread as the remainder of the cap" (Yan, column 4, lines 32-34). Accordingly, Yan teaches a configuration wherein the sweatband or foam liner is sewn to the headwear. In contrast with Yan, however, independent claim 1 recites that an elastic material is screenprinted onto a surface of the crown.

Consistent with the above discussion, the Office Action appears to recognize that Yan does not teach an elastic material screenprinted onto a surface of the crown. In an attempt to overcome this deficiency in Yan, the Office Action states that the use of screen printing to adhere the strip to the crown of the cap is not given patentable weight in this matter because one of ordinary skill in the art could choose any form of adhesion or stitching to apply the strip to the cap. In contrast with this assertion, however, Yan teaches away from a configuration wherein an attachment method other than thread is utilized. More particularly, Yan states that "It is still another important object of the invention to provide a cap which is formed with multi-directional, stretchable, woven fabric having a thin, synthetic foam band which has an over cover of the same fabric making up the majority of the cap and wherein the band is adhered to the body of the cap by means of stretchable thread" (Yan, column 2, lines 13-18). Accordingly, by expressly stating that it is an important aspect that the foam band be "adhered to the body of the cap by means of stretchable thread," Yan effectively teaches away from the assertions in the Office Action that one of ordinary skill in the art would choose "any form of adhesion or stitching to apply the strip to the cap."

Claim 3 recites that the strip includes a plurality of perforations. A thorough review of Yan, including Figure 6 (which is noted in the Office Action), does not reveal any perforations.

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Claims 6 and 8 cooperatively recite that the headwear includes a flap formed as an extension of the first elastic material, and the strip is located on the extension. In Yan, the textile member that surrounds the foam element is separate from the material forming the remainder of the cap and is not, therefore, an extension of the material forming the remainder of the cap.

Based upon the above discussion, the Applicants respectfully submit that independent claim 1 is allowable over Yan. In addition, claims 2-17 should also be allowable as neither Dodd nor Wang remedy the deficiencies in Yan discussed above.

### IV. Discussion of Claims 18-27

Independent claim 18 recites a cap having an adjustment system for accommodating various head dimensions. The cap includes a crown and a visor attached to the crown. The crown is for covering at least a portion of a head and is at least partially formed of a first elastic material. The crown includes a flap positioned adjacent an interior surface of the crown, and the crown including a strip of a second elastic material that is screenprinted onto the flap.

The Office Action rejects independent claim 18 as being anticipated by Yan. As discussed with respect to independent claim 1, however, Yan does not teach or suggest an elastic material that is screenprinted onto a flap. Furthermore, Yan teaches away from this configuration. Accordingly, independent claim 18 should be allowable over Yan for the same reasons that are discussed above for independent claim 1. Claim 21 recites that the strip includes a plurality of perforations. A thorough review of Yan, including Figure 6 (which is noted in the Office Action), does not reveal any perforations.

Based upon the above discussion, the Applicants respectfully submit that independent claim 18 is allowable over Yan. In addition, claims 19-27 should also be allowable as neither Dodd nor Wang remedy the deficiencies in Yan discussed above.

### V. Discussion of Claims 28-33

Independent claim 28 recites a cap having an adjustment system for accommodating various head dimensions. The cap includes a crown and a visor attached to the crown. The crown is for covering at least a portion of a head and is at least partially formed of an elastic textile. The crown includes a flap positioned adjacent an interior surface of the crown. The flap defines a first surface and an opposite second surface, with the first surface being oriented to face

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away from the head and the second surface being oriented to face the head. The crown also includes a strip of elastic silicone that is screenprinted onto the first surface, the strip including a plurality of perforations. The visor has a configuration that expands in response to a stretching of the crown.

The Office Action rejects independent claim 28 as being obvious over a combination of Yan and Dodd. As discussed with respect to independent claim 1, however, Yan does not teach or suggest an elastic material that is screenprinted onto a surface. Furthermore, Yan teaches away from this configuration. Accordingly, independent claim 28 should be allowable over Yan and Dodd for the same reasons that are discussed above for independent claim 1.

To establish a *prima facie* case of obviousness, the burden is upon the Examiner to demonstrate reasons why a skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. Accordingly, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. With regard to the present issue, the rejection does not establish a *prima facie* case of obviousness because no proper motivation exists to combine Yan with Dodd.

As a motivation for making the combination of Yan and Dodd, the rejection states that "It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Dodd to modify Yan in order to provide a cap where the second elastic material is silicone providing a waterproof, lightweight, and flexible strip in the inside of the crown" (Office Action, page 3, last sentence). As a first matter, there is no showing or even an attempt to demonstrate that a combination of Yan and Dodd would actually provide a waterproof structure to the cap. That is, the rejection merely asserts that the combination would provide a waterproof structure, but fails to recognize that air vents 20, which are for ventilation, would counteract this effect. Furthermore, the rejection fails to demonstrate that a teaching, suggestion, or incentive supporting the combination exists. Yan does not discuss a need for having a waterproof structure, and the Applicant is aware of no recognized understanding in the art that the cap of Yan would benefit from having a waterproof band around the lower peripheral edge. Accordingly, the rejection of independent claim 28 is improper for failing to establish a *prima facie* case of obviousness.

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As a further matter, independent claim 28 recites that the strip includes a plurality of perforations. As a motivation for combining Yan and Dodd, the rejection suggests that silicone would provide a waterproof structure, but the recited perforations would hinder this feature. In other words, the rejection utilizes a motivation that would be inoperable due to a recited element in the claim. Accordingly, one skilled in the art would not consider incorporating silicone into a cap for purposes of providing a waterproof structure if the silicone has a perforated structure.

Based upon the above discussion, the Applicants respectfully submit that independent claim 28 is allowable over Yan and Dodd. In addition, claims 29-33 should also be allowable as Wang does not remedy the deficiencies discussed above.

**VI. Discussion of Claims 43-51**

Independent claim 43 recites a cap having an adjustment system for accommodating various head dimensions. The cap includes a crown and a visor attached to the crown. The crown includes a plurality of panels formed from a first elastic material. The panels are attached together to form a generally hemispherical structure for extending over a head, at least one of the panels has a primary section and an extension. The primary section forms at least a portion of an exterior of the crown. The extension is attached to an edge of the primary section and is folded relative to the primary section and located adjacent to the primary section. The extension has a first surface oriented to face the primary section and an opposite second surface oriented to face the head. The crown also includes a strip of a second elastic material that is attached to the first surface, and the crown includes a sweatband attached to the second surface. The visor has a configuration that expands in response to a stretching of the crown.

The Office Action rejects independent claim 43 as being anticipated by Yan. Yan, however, does not teach or suggest both (a) an elastic material attached to a first surface of the extension and (b) a sweatband attached to a second surface of the extension. In addition to the crown and visor, Yan discloses a foam element that is wrapped by a textile. Although not specifically stated in the rejection, the Applicants presume that the Examiner analogizes the foam material to the elastic strip recited by independent claim 43 and also analogizes the textile to the extension recited by independent claim 43. Based upon this interpretation, Yan does not disclose a sweatband that is attached to the second surface of the extension.

Based upon the above discussion, the Applicants respectfully submit that independent claim 43 is allowable over Yan. In addition, claims 44-51 should also be allowable as Dodd and Wang do not remedy the deficiencies discussed above.

#### **VII. Discussion of Claims 57-62**

Independent claim 57 recites an article of headwear having an adjustment system for accommodating various head dimensions. The headwear has a crown for covering at least a portion of a head. The crown includes a textile material formed from a plurality of fibers or filaments, and the crown includes a strip of an elastic material. The strip is screenprinted onto a surface of the crown such that the elastic material infiltrates the textile material that extends around at least a portion of the fibers or filaments.

None of the references cited in the Office Action teach or suggest the concept of screenprinting an elastic material onto a crown of an article of headwear. In order to overcome this deficiency in Yan, the Office Action states that the use of screen printing to adhere the strip to the crown of the cap is not given patentable weight in this matter because one of ordinary skill in the art could choose any form of adhesion or stitching to apply the strip to the cap. None of the references teach or suggest, however, a configuration wherein the elastic material infiltrates the textile material that extends around at least a portion of the fibers or filaments, as recited by independent claim 57.

Based upon the above discussion, the Applicants respectfully submit that independent claim 57 is allowable over Yan, Dodd, and Wang, either alone or in combination. In addition, claims 58-62 should also be allowable for at least the same reasons.

#### **VIII. Conclusion**

In view of the foregoing, the Applicant respectfully submits that all claims are in a condition for allowance. The Applicant respectfully requests, therefore, that the rejections be withdrawn and that this application now be allowed.

This Amendment is being timely filed by facsimile transmission on January 5, 2006. Should additional fees or an extension of time be deemed necessary for consideration of this Amendment, such fees or extension are hereby requested and the Commissioner is authorized to charge deposit account number 19-0733 for payment. If anything further is desirable to place the

application in even better form for allowance, the Examiner is respectfully requested to telephone the undersigned representative at (503) 425-6800.

Respectfully submitted,

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